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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,349	12/03/1999	MICHAEL A. EPSTEIN	PHA-23-637	3613

24737 7590 11/17/2005

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER

SHERR, CRISTINA O

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/454,349

Applicant(s)

EPSTEIN, MICHAEL A.

Examiner

Cristina Owen Sherr

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to applicant's Brief on Appeal filed August 17, 2005.

Continued Examination Under 37 CFR 1.114

2. In view of the appeal brief filed on August 17, 2005, PROSECUTION IS HEREBY REOPENED. Claims 1-20 are currently pending in this case.

3. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

3. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

4. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kataoka et al (US 5,857,021A) in view of Spagna et al (US 6,587,837).

6. Regarding claims 1-3 -

Kataoka discloses a medium ID, corporate ID, and terminal ID, all of which are used to protect the use of the encrypted content material. The secure item claimed in this claim is an encryption/decryption key that is based on the unique identifier. In the case of Kataoka, the unique identifier is the medium ID (e.g. fig. 4, col 7 ln 5-10. col 5 ln 15-20). Although the cited art does not specifically claim such a unique identifier being generated by the first write operation, Kataoke does disclose encrypting data through known algorithms or key generating means (e.g. col 7 ln 5-10. col 5 ln 15-20). Thus steps need only be shuffled, reordered or repeated more time in order obtain a unique identifier. Mere reordering or repeating of steps at different stages does not constitute new art. Further, Spagna does disclose such a unique identifier being generated by the first write operation (e.g. col 64 ln 15-40). It would be obvious to one of ordinary skill in the art to combine the teachings of Spagna and Kataoka as they are in the same field and would tend to make each other more effective.

7. Regarding claims 4-7 -

Kataoka discloses a first decrypting means and second decrypting means which provide the content material only when the current value of the recording indicator corresponds to its original value. (e.g. Col 2 ln 13-34). Although the cited art does not specifically claim such a unique identifier being generated by the first write operation, Kataoke does discloses encrypting data through known algorithms or key generating means (e.g. col 7

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In 5-10. col 5 In 15-20). Thus steps need only be shuffled, reordered or repeated more time in order obtain a unique identifier. Mere reordering or repeating of steps at different stages does not constitute new art. Further, Spagna does disclose such a unique identifier being generated by the first write operation (e.g. col 64 In 15-40). It would be obvious to one of ordinary skill in the art to combine the teachings of Spagna and Kataoka as they are in the same field and would tend to make each other more effective.

8. Regarding claims 8-17 -

Kataoka discloses recording encrypted content material on a medium dependent on the content material and a content key (e.g. col 7 In 23-26) and further discloses recording a secure item (encrypted encryption key) which is encrypted using a private key that is generated using based on a recording indicator that is associated with the recording medium (medium ID and Unit ID) (e.g. col 7 In 9-12). Although the cited art does not specifically claim such a unique identifier being generated by the first write operation, Kataoke does discloses encrypting data through known algorithms or key generating means (e.g. col 7 In 5-10. col 5 In 15-20). Thus steps need only be shuffled, reordered or repeated more time in order obtain a unique identifier. Mere reordering or repeating of steps at different stages does not constitute new art. Further, Spagna does disclose such a unique identifier being generated by the first write operation (e.g. col 64 In 15-40). It would be obvious to one of ordinary skill in the art to combine the teachings of Spagna and Kataoka as they are in the same field and would tend to make each other more effective.

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9. Regarding claims 18-20 -

Kataoka discloses a claimed unique key that is the private key, the encrypted content key is decrypted using this private key, and then the encrypted content is decrypted using the content key (e.g. Col 2 Ln 13-34). Although the cited art does not specifically claim such a unique identifier being generated by the first write operation, Kataoke does disclose encrypting data through known algorithms or key generating means (e.g. col 7 Ln 5-10. col 5 Ln 15-20). Thus steps need only be shuffled, reordered or repeated more time in order obtain a unique identifier. Mere reordering or repeating of steps at different stages does not constitute new art. Further, Spagna does disclose such a unique identifier being generated by the first write operation (e.g. col 64 Ln 15-40). It would be obvious to one of ordinary skill in the art to combine the teachings of Spagna and Kataoka as they are in the same field and would tend to make each other more effective.

10. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

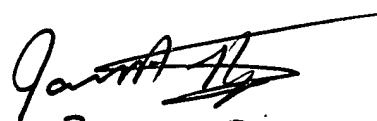
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

COS


Primary Examiner
AU 3621